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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 09/998,111

Conf. No.: 4393

Filing Date: 11/30/2001

Art Unit: 3622

Applicant: Hubbard et al.

Examiner: Duran, Arthur D.

Title: SYSTEM AND METHOD FOR
PRESENTING MARKETING
CONTENT ON A WEB PAGE

Docket No.: CA920000060US1
(IBMR-0111)

COMMISSIONER FOR PATENTS

DESTINATION FACSIMILE NUMBER: 571-273-8300

Transmitted herewith is:

Notice of Appeal, Pre-Appeal Brief, and
Extension of time in 6 pages

in the above identified application.

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(IBMR-0111)Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicants respectfully request a panel of experienced examiners perform a detailed review of appealable issues for the above-identified patent application pursuant to the Pre-Appeal Brief Conference Pilot Program. Applicants submit that the above-identified application is not in condition for appeal because the Office has failed to establish a prima facie case of obviousness based on an error in facts. Claims 1-26 are pending in this application.

Turning to the rejection, in the final Office Action, claims 1-55 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,848,396 (Gerace) in view of U.S. Patent No. 6,078,916 (Culliss). Applicants submit that this rejection is clearly not proper and without basis because at least one claim limitation is not met by the combined references. As argued in the October 24, 2005 After Final Amendment, the Examiner is attempting to hold applicants to a heightened standard by suggesting that Applicants must argue against portions of the particular reference not cited by the Examiner. See Request for Reconsideration, pages 17-18. Furthermore, the Examiner is requiring that Applicants argue against references that the

Examiner has not specifically cited with respect to a particular feature of the claimed invention. See Request for Reconsideration, pages 18-19. As Applicants believe that they have successfully shown reasons that the cited portions of the cited references do not show all of the claimed elements of the invention, Applicants request that the Examiner specify the portions of the references that the Examiner believes supports the rejections or withdraw the rejections.

In particular, Applicants submit that Gerace fails to teach a marketing page element placed on the web page, the marketing page element providing storage for data items having marketing content for a marketed item, wherein the data items are for displaying on the web page. See Request for Reconsideration, page 19. The portions of Gerace cited by the Office do not show a web page, but instead a program, which includes advertisement module. To this extent, Gerace does not teach that advertisement module 75 is an element (hence the name marketing page *element*) of the web page that is placed on the web page. The Office further, in the alternative, equates the marketing page element of the claimed invention with a Page Display of Gerace, which the Office states "...has certain areas designated for displaying marketing content...[which] can be considered as items." Request for Reconsideration, page 19-20. In support, the Office cites a passage of Gerace that describes the set of Page Display Objects. Final Office Action, page 15, par. 3; citing Gerace, col. 7, lines 23-37. However, the Page Display Objects of Gerace cited by the Office are not a Page Display nor are they elements of a web page that are placed on the web page, but only Page Display Objects that *define* the screen views transmitted and displayed to end users.

Applicants further contend that Gerace fails to teach or suggest that the data items correspond to a marketed item as asserted by the Office. Request for Reconsideration, pages 21-22. The Office argues that that an advertisement that results in a purchase is equivalent to

presenting data items related to a marketed item such as a product or coupon. However, Applicants assert that the passage of Gerace cited by the Office teaches only the recording of history of users viewing the advertisements and actions taken therefrom, and still does not teach or suggest that the data items correspond to a marketed item.

Applicants still further submit that Gerace also fails to teach that the marketing strategy is specified by a business rule in an if - then (action) format. Request for Reconsideration, pages 22-23. Instead, Gerace teaches an Ad Series Object that provides an indication of the demographic group pre-requested by the sponsor to be shown that advertisement, but does not teach that it uses a business rule in an if - then (action) format.

Applicants realize that the Examiner has cited multiple references, not simply Gerace, in his rejections. However, the Office has cited only passages of Gerace to support its position that the cited references teach certain limitations of the claimed invention. Applicants argue that the portions of Gerace that the Office cites do not teach the limitations of the claimed invention. Applicants can find nowhere else in Gerace or the cited references that teach the limitations of the claimed invention.

Accordingly, Applicants submit that the Office has failed to state a prima facie case of obviousness, and this application is not in condition for appeal and should either be allowed as is, or re-opened for further prosecution.

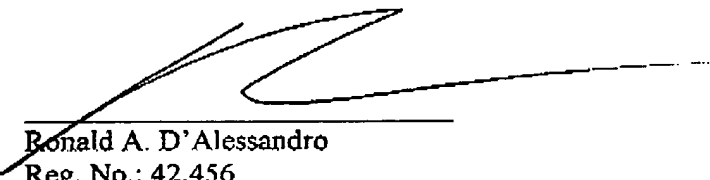
With respect to the rejections of independent claims 10, 22, 34, and 48, Applicants note that each claim includes a feature similar in scope to claim 1. Further, the Office relies on the same arguments and interpretations of Gerace as discussed above with respect to claim 1. To this extent, Applicants herein incorporate the arguments presented above with respect to claim 1, and respectfully request withdrawal of the rejections of these claims for the above-stated reasons.

With respect to dependent claims, the dependent claims are believed to be allowable based on the above arguments, as well as for their own additional features.

Applicants respectfully submit that the application is not in condition for appeal. Should the examining panel believe that anything further is necessary to place the application in better condition for allowance or for appeal, they are requested to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,

Date: December 12, 2005



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